THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STANLEY N. LAPIDUS

Appeal No. 95-1950
Application 08/061,928[1]

HEARD: Jun. 8, 1998

Before KIMLIN, GARRIS, and OWENS, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

---

[1] Application for patent filed May 13, 1993. According to appellant, this application is a continuation of Application 07/884,622, filed May 15, 1992, now U.S. Patent 5,266,495, issued November 30, 1993; which is a continuation of Application 07/487,637, filed March 2, 1990, now abandoned.

This is a decision on an appeal which involves claims 1 through 3, 8, 12 and 13.[2] The only other claims remaining in the application, which are claims 4 through 7 and 9 through 11, have been allowed.

The subject matter on appeal relates to a method and apparatus for collecting for image analysis a selected quantity of particles having a known average size above a threshold size and that are in a fluid medium. Further details of this appealed subject matter are set forth in illustrative independent claim 1, a copy of which taken from the specification is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Zahniser et al. (Zahniser)	4,395,493	Jul. 26, 1983
Hunt et al. (Hunt)	4,583,396	Apr. 22, 1986

[2] As a matter of clarification, we point out that the issues raised by the appellant in his brief regarding the examiner's objections to the application drawing are resolvable by way of petition not appeal which the examiner correctly observed on page 2 of the answer. See generally, In re Hengehold, 440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971) and In re Searles, 422 F.2d 431, 435, 164 USPQ 623, 626 (CCPA 1970).

Mukogawa et al. (Mukogawa) 4,765,963 Aug. 23, 1988

Claims 1 through 3, 8, 12 and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over Zahniser in view of Hunt.

Claims 1, 3 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Mukogawa, and claim 2 is correspondingly rejected over this reference and further in view of Hunt.

Preliminarily, we observe that the independent claims have been separately grouped; see the paragraph bridging pages 6 and 7 of the brief. Accordingly, the dependent claims on appeal will stand or fall with these independent claims.

We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellant and the examiner concerning the above noted rejections.

OPINION

For the reasons which follow, we will sustain the rejection based on Zahniser in view of Hunt, but we will not sustain either of the rejections based on Mukogawa alone or further in view of Hunt.

We agree with the appellant that Mukogawa contains no teaching or suggestion of terminating the fluid signal in response to a selected change in the measured parameter as recited in clause D or for transferring the particles to an optical element for image analysis as recited in clause E of the independent claims under rejection. Concerning the clause D feature, the examiner urges that the "prescribed time in Mukogawa. . . is viewed as the presently recited measured parameter" (answer, page 6). This view is clearly erroneous since the here claimed "measured parameter" is explicitly defined in clause C as "responsive to fluid flow", and Mukogawa's time parameter is plainly not so responsive. As for the clause E feature, we cannot agree with the examiner that it would have been obvious to combine the prior art embodiment described in column 1 of Mukogawa with patentee's figure 1 embodiment. In our opinion, the appellant is correct in arguing that these embodiments are alternative, and thus not combinable, mechanisms for determining water purity.

In light of the foregoing, we cannot sustain the examiner's section 103 rejection of claims 1, 3 and 8 as being unpatentable over Mukogawa. Moreover, we also cannot sustain

the rejection of claim 2 as being unpatentable over Mukogawa in view of Hunt since at least one of the above discussed deficiencies would persist even if these reference teachings were combined in the manner proposed by the examiner.

Concerning the rejection based on Zahniser in view of Hunt, we agree with the examiner's basic position that the cumulative teachings of these references would have suggested to one with ordinary skill in the art replacing Zahniser's cell counter mechanism with a counter mechanism of the type taught by Hunt. According to the appellant, these references contain no suggestion of why or how to combine their teachings in such a manner as to result in the here claimed invention. This viewpoint is not well founded.

An artisan with ordinary skill would have been motivated to effect the above noted replacement in order to obtain the advantages taught by Hunt, namely, the substitution of a simple and speedy counter mechanism for a relatively expensive and complicated one (e.g., see lines 19 through 25 in column 1) such as the one taught by Zahniser. Further, the artisan would have achieved this desideratum by measuring fluid pressure or flow across Zahniser's filter in accordance with

the teachings of Hunt. In this regard, we emphasize that Hunt expressly teaches utilizing his counter mechanism on a movable strip in the form of a filter (e.g., see lines 17 through 28 in column 2) which corresponds to the movable filter tape of Zahniser and that Hunt expressly teaches using his mechanism as a particle counter (e.g., see lines 59 through 64 in column 4).

For the above stated reasons, it is our determination that the reference evidence adduced by the examiner establishes a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. At this point, therefore, it is appropriate to re-assess all the evidence of record including the appellant's evidence of nonobviousness in order to reach an ultimate conclusion of obviousness versus nonobviousness. See, for example, In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

As evidence of nonobviousness, the appellant offers the Zahniser and Farber declarations of record under 37 CFR 1.132 (see paper numbers 5 and 8 respectively).

For the most part, the Zahniser declaration describes operational problems which developed in attempting to count cells or particles in the manner taught by the Zahniser patent. In our view, this aspect of the Zahniser declaration reinforces the above discussed desirability of replacing an expensive and complicated counter mechanism of the type disclosed in the Zahniser patent with a simple and speedy counter mechanism of the type taught by Hunt. To this extent, the Zahniser declaration tends to support a conclusion of obviousness rather than nonobviousness.

The Farber declaration describes the advantages and praise therefor by others resulting from use of an instrument referred to as the "ThinPrep Processor" in comparison to conventional cytology practices such as conventional Pap smear testing. However, this comparison has little if any probative value in relation to the obviousness issue before us since it relates to conventional cytology practices such as Pap smear testing rather than the closest prior art represented by the method and apparatus described in the Zahniser patent. In re Merchant, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978) (applicant must compare his claimed invention with closest

prior art to rebut a prima facie case). For example, the advantages described in the Farber declaration (e.g., see item 10 on page 10) relative to the "ThinPrep Processor" instrument appear to be also applicable to the apparatus described in the Zahniser patent. In re Baxter Travenol Labs, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) (mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention).

In addition, the above noted "ThinPrep Processor" instrument is not described in the Farber declaration with specificity sufficient to allow an informed assessment of declarant's statement "I consider the advantages summarized above in Paragraphs 6, 7 and 9-15 to be, at least in part, the direct result of both collecting and counting the cells on the filter element of the ThinPrep Processor instrument in a manner described in this application for patent" (declaration, page 14) particularly in relation to whether the proffered evidence of nonobviousness is commensurate in scope with the claims on appeal. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); In re Altenpohl, 500 F.2d 1151, 1159, 183 USPQ 38, 44 (CCPA 1974). Finally, the

declarant's opinion at item 17 on page 14 that "such claimed subject matter is unobvious" is entitled to little if any weight since it amounts to an expression of ultimate legal conclusion. In re Altenpohl, id.

The circumstances recounted above lead us to determine that the evidence of record on, balance, weighs most heavily in favor of an obviousness conclusion. We shall sustain, therefore, the section 103 rejection of claims 1 through 3, 8, 12 and 13 as being unpatentable over Zahniser in view of Hunt.

The decision of the examiner is affirmed.

AFFIRMED

Edward C. Kimlin Administrative Patent Judge	)	
Bradley R. Garris Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Terry J. Owens Administrative Patent Judge	)	

Appeal No. 95-1950
Application No. 08/061,928

Patent Administrator
Testa, Hurwitz & Thibeault, LLP
High Street Tower
125 High Street
Boston, MA 02110

APPENDIX

1. A method for collecting for image analysis a selected quantity of particles having a known average size above a threshold size and that are in a fluid medium, comprising the steps of A. providing a flow path for the fluid medium, with the particles carried therein, across a filter device having a substantially uniform distribution of apertures of substantially uniform size for blocking particles above said threshold size and passing smaller particles,

B. applying a known fluid signal to the flow path, including across said filter device,

C. measuring a parameter responsive to fluid flow through said filter device due to said applied fluid signal and which changes according to blockage of said filter device by particles above said threshold size,

D. terminating said fluid signal in response to a selected change in said measured parameter, and

E. transferring the particles collected on said filter device, after said selected change in said measured parameter, to an optical element for image analysis.